

**R E M A R K S**

In the Office Action mailed June 26, 2002, the Examiner makes a nonstatutory double patenting rejection based on a judicially created doctrine grounded in public policy, over commonly owned co-pending application Ser. No. 09/409,524. A terminal disclaimer is submitted herewith, to overcome such rejection. The Examiner is respectfully requested to withdraw the rejection.

Further, the Examiner rejects claims 1-24 over various prior art references. The rejections, insofar as they may be applied to the claims as amended, are respectfully traversed for the reasons indicated below. Reconsideration of the application, as amended, and withdrawal of the rejections are respectfully requested.

Claims 1 - 24 remain in the case, claims 1- 16, 18 – 19, 21 and 24 having been amended.

Claims 1, 3, 5-10, and 21 – 24 stand rejected under 35 USC §103(a) as being unpatentable over a combination of Ferguson et al., U.S. Patent No. 5,819,902 (“Ferguson”), and Hunter et al., U.S. Patent No. 6,298,327. Claims 2, 4 and 11-20 stand rejected under 35 USC § 103(a) further in view of Bezos et al., U.S. Patent No. 5,819,092 (“Bezos”). For the reasons including, inter alia, those discussed below, each of independent claims 1, 8, 11, 15, 21 and 24 as amended is patentable over the applied reference. Moreover, each of the claims dependent therefrom is patentable.

**The Claimed Invention**

As described in the application, the invention is directed to solving the problem of seeking protection for intellectual property assets, potentially in multiple jurisdictions. Intellectual property owners are faced with a landscape of national requirements-based and foreign associate-based variations in formal or procedural requirements. In spite of the magnitude of the problem and the need for a solution, prior art devices simply have not solved this problem. “Recognizing the limitations of currently available systems, a facility has been developed whereby an applicant (or his representative) may initiate performance of an intellectual property service such as the making of a maintenance fee, annuity, renewal, tax or other payments and transact the associated fees coincident therewith. . . . Outside the context of annuity-type payments, similar facilities

may be employed in conjunction with preparation, filing and prosecution support tools to similarly transact fees associated with the performance of intellectual property services at or about the time such intellectual property services are performed.”

The invention, as claimed, is directed to a method for transaction an intellectual property service in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions (claim 1); a method for transacting intellectual property annuity, maintenance or renewal fee payments (claim 8); a method of operating an information service to facilitate fee transactions in connection with the filing of documents and/or payment of fees relating to intellectual property services (claim 11); an information system for transacting fees associated with intellectual property services in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions (claim 15); a computer program for transacting an intellectual property service in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions (claim 21); and an intellectual property filing preparation system (claim 24); all as further claimed.

By way of example, one element of claim 1 as amended provides for “providing a user with information representative of one or more intellectual property services and one or more fees associated therewith, wherein the fees include one or more of: official fees and service fees.” As another example, an element of claim 8 as amended calls for “providing, responsive to docket data, information representative of one or more intellectual property matters and one or more fee payments associated therewith...” Further, claim 11 as amended includes the element of “registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of fees for one or more intellectual property services performed by the associated therein.” Claim 15, as amended, includes by way of example, “an intellectual property service portal coupled by the network to the originating node and one or more of the target nodes, the intellectual property service portal responsive to a selection at the originating node of at least one intellectual property service, supplying the originating node with information representative of one or more fees corresponding to the selected at least one intellectual property service...” As another example, claim 21 as amended concerns “a computer program product encoded in a computer readable medium for transacting an intellectual property service”.

**U.S. Patent 5,819,092 (Ferguson)**

Independent claims 1, 8, 11, 15, 21 and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ferguson in combination with other reference(s). The rejection, insofar as it might be applied to the claims as amended, is respectfully traversed for the following reasons, which are provided by way of example.

Ferguson concerns an online service development tool with fee setting capabilities. It is addressed to creating a sophisticated commercial online service with the ability to define fee structures for accessing parts of the online system and/or ordering other goods or services that usually requires specialized programming (e.g., Col. 3, lines 56-61). The Examiner admits that Ferguson has nothing to do with intellectual property.

Ferguson is addressed to the problem that there is a “need to create online system development tools that include features, functions and capabilities to support commercial online services such as the aforementioned fee setting function.” Col. 4, lines 12-15. Ferguson “discloses a software tool for setting fees in an online service, as part of a visually oriented tool for creating online services.” Col. 1 lines 12-15.

Notable sections of Ferguson, according to the Office Action, state that an object of the invention is “to provide a sophisticated fee setting tool that allows a developer to assign a system of fees for access to an online service. The fee setting tool allows complex fee arrangements to be created using a well defined scripting language.” Col. 4 lines 28-32. Further, the fee structure for the online service can handle fees levied against both users and third party content providers, e.g., “for logging onto an online service, performing searches, or downloading information.” Col. 4, lines 51-57. Accordingly, the user can initiate an electronic transaction to download, price, purchase, rent, reserve, etc. the online document “that contains images and text describing the goods and services”, or the goods/services described therein. As further described the notion of “transaction” is a real time electronic transaction (e.g., debit a user’s account), a real-time manual transaction (e.g., a clerk checks inventory and responds), delayed electronic transaction (e.g., queued transactions for batch processing) and delayed manual transaction (e.g., bids received by an antique dealer) (Col. 8 line 63 - Col. 9 line 53).

The Office Action also cites Ferguson's "Fee Setter subtool" as being relevant. According to Ferguson, "the actual transfer of monetary funds specified by the Fee Setter can be effected on an immediate or periodic basis." Col. 29 lines 45-46.

In summary, Ferguson teaches a fee setting tool for charging fees on a periodic basis or use basis for online services. Ferguson explains a certain fee setting framework and consequently does not teach or suggest, *inter alia*, specifics of the online services to be delivered thereby.

**U.S. Patent 6,298,327 (Hunter)**

Independent claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter in view of Ferguson (discussed above). The Office Action also cites Ferguson to attempt to remedy the deficiencies of Ferguson with regard to certain other rejections. The rejections, insofar as they may be applied to the claims as amended, are respectfully traversed for reasons including the following.

Hunter discloses a computer-implemented expert support system for authoring invention disclosures and evaluating patentability/marketability of an invention. According to Hunter, it "provides appropriate information on 'how to' prepare the different sections of an invention disclosure." (Col. 4 lines 46-49.) Objects of the invention include, among others, facilitating the authoring of a disclosure for the purpose of a patent application, and facilitating the authoring of a specification of a patent application. (Col. 6, lines 2-18.) Hunter intends to "facilitate[] communication of invention characteristics and enable[] output of invention disclosures in a plurality of formats, including that of a patent application." (Abstract.) Hunter does not discuss the actual filing of the application, nor does Hunter discuss anything concerning fees associated with the filing. Indeed, any discussion of filing or fees in Hunter would be premature, since Hunter is directed to the problem of enabling "inventors to adequately disclose (communicate) the characteristics of their inventions." (Col. 2, lines 43-45.)

**Claims in Contrast to Ferguson and Hunter**

Ferguson is directed to an online service development tool with a fee setter subtool. Hunter is directed to an expert system for authoring an invention disclosure. Nothing in Ferguson would suggest that the online service could be an expert system, let alone one sufficiently complex so as to handle intellectual property filings. Additionally, nothing in Hunter suggests anything further

than an initial draft of an invention disclosure, but does not suggest filing the disclosure itself nor attending to payment of fees in connection with official filings nor any of the other complexities attendant to intellectual property services. Consequently, Ferguson and/or Hunter operate in a fundamentally different way than the claimed invention. Specifically, neither Ferguson nor Hunter teach or even suggest, let alone disclose, anything concerning intellectual property services in connection with the filing of documents and/or payment of fees relative to one or more target jurisdictions, as claimed.

Moreover, there is no suggestion or motivation to combine the references. The Office Action provides no motivation to combine the references, other than a conclusory statement in paragraph 16 that the combination would be made “for the advantage of providing a method of transacting an intellectual property service.” Hunter itself does not provide a motivation to combine its expert system with Ferguson’s online service development tool, nor does Ferguson provide a motivation to offer an expert system of any type, let alone Hunter’s expert system.

Assuming arguendo a motivation to combine the two references, the proposed modification would appear to change the principle of operation of either Hunter or Ferguson, or both. Ferguson does not appear to be appropriate to use with an expert system, as taught by Hunter. Further, Hunter does not appear to be appropriate for use as a third party content provider, as taught by Ferguson. Hence, the proposed combination would appear to require a substantial redesign of Ferguson, as well as some basic changes to the principles upon which Ferguson operates in order to accommodate an expert system.

Moreover, the proposed combination fails to make obvious the invention as claimed. Examples are provided in the following section as to some of the deficiencies that remain in the proposed combination, if made.

With regard to Claim 1, the Office Action states that Ferguson discloses a computer implemented method for transaction a service. To the contrary, Ferguson discloses a method of “transacting” a fee, associated with a purchase of merchandise or a content service. Recognizing that Ferguson does not teach that the service could be an intellectual property service, the Office

Action cites Hunter. The Office Action states that Hunter teaches a computer-implemented method for operating an intellectual property service. To the contrary, Hunter teaches an expert system for authoring (but not filing) a patent disclosure.

The Office Action argues that it would have been obvious to have included Hunter's expert authoring system in Ferguson's online service development tool with fee setting feature. Nevertheless, there is nothing in Ferguson that suggests that it may be used in connection with an expert system. Ferguson concerns online services; Hunter does not have an online service. Ferguson alternatively allows a user to purchase a product; Hunter has no product.

Moreover, assuming *arguendo* that it would have been obvious to combine Ferguson and Hunter, that combination would still be deficient.

As per claim 3, the Office Action argues that Hunter discloses certain things about fee transaction. Hunter says nothing about fees. The Office Action admits this as it fails to recite any section of Hunter concerning fees.

As per claim 5, the Office Action erroneously states that Ferguson and Hunter disclose initiating intellectual property services in response to a docket event. Notably, neither Ferguson nor Hunter discuss any docket. The Office Action has already admitted that Ferguson does not suggest intellectual property services, hence, it is not surprising that Ferguson does not suggest details of an intellectual property service such as a docket. As Hunter does not concern the actual filing of documents, it is not surprising that it does not discuss a docket.

As per claim 6, the Office Action erroneously states that Ferguson and Hunter disclose retrieving intellectual property application information from a data store and calculating the fee based thereon. To the extent that this rejection may be applied to claim 6 as amended, it is respectfully traversed. Hunter expressly does not cover fee calculations (Col. 11 lines 34-35). Moreover, Hunter certainly does not suggest or teach retrieving information characterizing an intellectual property application corresponding to one or more intellectual property services, on which to base such a calculation. Also, as discussed above, Ferguson discloses nothing about intellectual property, and certainly does not suggest that any information regarding an intellectual property application corresponding to an intellectual property service can be retrieved and used for calculating a fee.

As per claim 7, the Office Action erroneously states that Ferguson and Hunter disclose supplying information encoding the services and fees for use in an accounting system. To the contrary, neither Ferguson nor Hunter teach or suggest supplying information encoding intellectual property services and associated fees, for use in an accounting system. There simply is no teaching or suggestion of encoding services and fees in Ferguson, which of course has nothing to do with intellectual property in any event. Not surprisingly, Hunter is unconcerned with fees and has nothing to teach or suggest concerning the same, let alone encoding them and/or supplying same for use in an accounting system. If the Examiner maintains that Hunter is relevant to claim 7, he is respectfully requested to point to a particular relevant portion of Hunter.

As per claim 8, the Office Action erroneously states that Ferguson discloses intellectual property annuity, maintenance, or renewal fee payments. To the contrary, Ferguson is entirely devoid of any teaching or suggestion regarding intellectual property. Consequently, Ferguson has nothing to do with payments of intellectual property annuity, maintenance or renewal fees. Further, Ferguson has nothing to do with “providing, responsive to docket data”, as claimed information representative of the intellectual property matters and fees. The Office Action admits that Ferguson does not disclose presenting anything based on docket data. In an attempt to remedy the deficiencies of the primary reference, the Office Action argues that Hunter teaches presenting information based on docket data. To the contrary, Hunter also teaches nothing about dockets, let alone docket data. (It is noted that the Office Action contains typographical errors in the citations to Hunter in paragraph 23.) Consequently, the combination of Hunter and Ferguson proposed in the Office Action, even if made, fails to make obvious the claimed invention.

As per claim 9, the Office Action erroneously states that Ferguson and Hunter disclose presenting a set of intellectual property matters (based on docket data per claim 8) and associated fee payments, and that initiating performance of the fees payments are performed by the intellectual property annuity, maintenance or renewal fee payment service. For the reasons discussed above, neither Ferguson nor Hunter teach or suggest anything about maintenance, renewal or annuity payments, let alone the details of claim 9, as amended.

As per claim 10, the Office Action erroneously states that the providing of information (based on docket data per claim 8) on the intellectual property matters and associated fee

payments is performed by an intermediary separate from the fee payment service. Again, as discussed above, neither Ferguson nor Hunter teach or suggest anything about maintenance, renewal or annuity payments, or that such payments could be performed by an intermediary as claimed. Ferguson and Hunter are simply unaware of the details of an intellectual property practice, and hence do not disclose anything regard such.

As per claim 21, the arguments above in connection with Claim 8 are equally applicable to claim 21. Moreover, the Office Action erroneously states that Hunter teaches selection code to select from amongst one or more intellectual property services as claimed. Insofar as this argument may be applied to claim 21 as amended, the rejection is respectfully traversed. Hunter certainly does not suggest initiating performance of an intellectual property service by the selected one or more intellectual property services. Further, as discussed above Hunter neither teaches nor suggests fees as claimed.

As per claim 22, the Office Action's rejection is based on the erroneous notion that Ferguson and Hunter can be combined. As discussed above, there is no motivation to combine the references; moreover, even if the references are combined, they fail to yield the invention as claimed. Again, here the combination discloses nothing about where the selection code and the fee transaction code are executable. Since the transaction necessitating the fee has traditionally been performed completely separate from the selection of the intellectual property services, there simply is no motivation to combine the references.

As per claim 24, the Office Action argues that Hunter and Ferguson together disclose the claimed invention. For the reasons previously discussed, there is no motivation to combine Hunter with Ferguson. Moreover, even if such a combination were made, it would not yield the claimed invention (as amended).

#### **U.S. Patent 6,029,141 (Bezos)**

Claims 2, 4 and 11-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ferguson in view of Hunter, and further in view of Bezos. Some of the deficiencies of Ferguson and Hunter are explained above; there are additional deficiencies in relation to the claims as amended. Bezos fails to remedy the deficiencies. The rejection is respectfully traversed for the following reasons, which are provided by way of example.

Bezos, U.S. Patent No. 6,029,141, discloses “an Internet-based referral system that enables individuals and other business entities (‘associates’) to market products, in return for a commission, that are sold from a merchant’s Web site. The system includes automated registration software that runs on the merchant’s Web site to allow entities to register as associates.”(Abstract.) A catalog distributed to an associate includes a referral link to the merchant’s site; when a customer purchases a product from the merchant’s site, the referral link allows a commission to be credited to the referring associate. (E.g., Abstract).

**Claims 4 and 11-20 in Contrast to Ferguson, Hunter and Bezos**

As per claims 11 and 15, the Office Action erroneously states that Bezos teaches the registering for each of plural target nodes (allegedly associates) (but not for target jurisdictions), and using a respective one of the associates when transacting associated intellectual property services. Deficiencies of Ferguson and Hunter are discussed above. The following are examples of some of the Office Action’s errors in characterizing Bezos. First, Bezos neither teaches nor suggests anything regarding intellectual property services. Second, Bezos neither teaches nor suggests anything regarding target jurisdictions as claimed. Further, per Bezos, an associate is an entity that registered with the merchant, and the associate receives a commission from the merchant (e.g., Col. 6, lines 31-40). Further, per Bezos, it is the merchant (not the associate) that sells products/services, and the associate receives a commission from the merchant (e.g., Col. 8, lines 55-58).

As per claim 2, the Office Action erroneously cites Ferguson as teaching intellectual property services that may be the paying of an annuity or maintenance fee. To the contrary, Ferguson has nothing to do with intellectual property, let alone payment of fees that are included in the intellectual property service. The Examiner further considers that the payment of fees (citing Ferguson) is completely different from the intellectual property service (citing Hunter). This further indicates that the references fail to teach or even suggest the claimed invention. Hunter fails to teach or even suggest documents specific to a target jurisdiction and an associate which may be used for directing and/or effecting a filing and/or payment of fees.

Also, the Office Action fails to cite any portion of any reference that allegedly teaches or suggests distributing information representative of one or more of the target jurisdictions, and

one or more associates registered therefor (in addition to the corresponding fees). None of the references, in fact, teaches or suggests distributing such information.

As per claim 4, there is no suggestion or teaching whatsoever in any combination of Ferguson, Hunter and/or Bezos of target jurisdictions and respective associates for at least a portion of the target jurisdictions. It appears that the Office Action argues that Hunter teaches target jurisdictions (eg., USPTO, EPO), and argues that Bezos teaches registered associates. However, as noted above, the Bezos associates are registered with a merchant, and it is the merchant that sells products/services. Nothing in any combination of Bezos, Hunter and/or Ferguson suggests that associates (of any type) can be associated with a target jurisdiction.

As per claim 12, the Office Action cites Hunter as teaching distributing (of information representative of target jurisdictions, associates registered therefore and corresponding fees) as claimed. As explained above, neither Hunter nor the other references teach associates registered in target jurisdictions. In addition to the deficiencies with respect to the claims from which claim 12 depends, nothing in any of the references suggests that information should be distributed responsive to selection of target jurisdictions and respective associates.

As per claim 13, the Office Action cites Ferguson and Hunter as teaching the periodic distribution of the computer readable encoding of fees for services. The deficiencies of the cited references have been previously discussed. The cited sections of Ferguson and Hunter fail to remedy the deficiencies.

As per claim 14, the Office Action cites Ferguson, Hunter and Bezos as teaching the periodic distribution of the computer readable encoding of fees for services. The deficiencies of the cited references have been previously discussed. The cited sections of Hunter fail to remedy the deficiencies.

As per claim 16, the Office Action erroneously states that the references teach, *inter alia*, fees of the selected associate for performing the intellectual property service. This refusal, insofar as it may be applied to claim 16 as amended, is respectfully traversed. As discussed above, Bezos teaches that the merchant, not the associate, sells the selected product. Moreover, none of the references teach that the one or more fees, for a particular selected target jurisdiction and associate combination, include one or more official fees for an intellectual property filing in the

particular selected target jurisdiction, and one or more service fees of the selected associate for performing the intellectual property service(s). The references are completely devoid of teaching or suggesting that the fees may include the official fees for the filing in the jurisdiction, and the associate fees for the associate performing the service.

As per claim 17, the Office Action cites Ferguson, Hunter and Bezos as teaching the invention as claimed. The deficiencies of the cited references have been previously discussed. The cited sections of Hunter fail to remedy the deficiencies.

As per claim 18, the Office Action cites Ferguson, Hunter and Bezos as teaching the invention as claimed. The deficiencies of the cited references have been previously discussed. The cited sections of Hunter fail to remedy the deficiencies.

As per claim 19, the Office Action cites Ferguson, Hunter and Bezos as teaching the invention as claimed. The deficiencies of the cited references have been previously discussed. The cited sections of Bezos fail to remedy the deficiencies.

As per claim 20, the Office Action cites Ferguson, Hunter and Bezos as teaching the invention as claimed. The deficiencies of the cited references have been previously discussed. The cited sections of Hunter and Ferguson fail to remedy the deficiencies.

### **Summary**

For at least these reasons, the combination of features recited in independent claims 1, 8, 11, 15, 21 and 24 when interpreted as a whole, is submitted to patentably distinguish over the prior art.

With respect to the rejected dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 8, 11, 15, or 21, but also because of additional features they recite. Examples of some of these features were discussed above.

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret

any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

#### **Conclusion**

For all the reasons advanced above, Applicant respectfully submits that the rejection of claims 1-24, insofar as it may be applied to the claims as amended, must be withdrawn. Consequently, issuance of a Notice of Allowance is respectfully requested.

#### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fee that may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,



Cynthia K. Nicholson  
Registration No. 36,880

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HALE AND DORR LLP  
1455 Pennsylvania Ave.  
Washington, D.C. 20004  
(202) 942-8437 (telephone)  
(202) 942- 8484 (facsimile)



## APPENDIX A

**Marked-up Copy of Amended Pages of Specification**

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Licensed or otherwise authorized to perform intellectual property services in one or more target jurisdictions. The intellectual property service portal is coupled by the network to the originating and target nodes and is responsive to a selection at the originating node of at least one intellectual property service, supplying the originating node with particularized fees for the 5 selected at least one intellectual property service. The intellectual property service portal is further responsive to initiation, from the originating node, of the selected at least one intellectual property service, transacting the particularized fees coincident therewith.

In still yet another embodiment in accordance with the present invention, a computer program product is encoded in a computer readable medium. The computer program product 10 includes selection code and fee transaction code. The selection code is executable to select from amongst one or more intellectual property services supported by one or more information services therefor. The fee transaction code is executable to transact one of more fees associated with the selected one or more intellectual property services coincident with performance thereof by a corresponding one or ones of the information services. The selection code and fee 15 transaction code may or may not be executable on the same processor.

In still yet another embodiment in accordance with the present invention, an intellectual property filing preparation system includes means for selecting from amongst one or more intellectual property services; means for initiating performance of the selected one or more intellectual property services; and means for transacting fees coincident with the performance of 20 the selected one or more intellectual property services.

**DESCRIPTION OF THE PREFERRED EMBODIMENT(S) BRIEF DESCRIPTION OF DRAWINGS**

The present invention may be better understood, and its numerous objects, features, and advantages made apparent to those skilled in the art by referencing the accompanying drawings.

25 **FIG. 1** is a block diagram depicting functional relationships between originating filers, an intellectual property filing portal, associates (including foreign

filings for more than one target jurisdiction. Similarly, more than one associate and hence more than one networked information server may service a given target jurisdiction. For example, in the illustration of **FIG. 1**, associated system 132 offers filing services for the United Kingdom through **UKPO 151** and for European Patent Convention filings through **EPO 141**. In contrast, 5 associate 131 offers filing services only for the United Kingdom.

Typically, a law firm will have the option of interacting with intellectual property filing portal **110** both as an originating filer and as an associate. For example, the information systems 131 of an illustrated UK associate services filings into United Kingdom Patent Office **151** but also interacts with intellectual property filing portal **110** as an originating filer to allow filings via 10 intellectual property filing portal **110** as described above (e.g., in German Patent Office **152** via information systems 133 of the illustrated German associate). Accordingly, although the intellectual property filing system is illustrated in the context of single direction flows of filings, persons of ordinary skill in the art will appreciate that, at least in some realizations, intellectual property filing portal **110** provides a fully bi-directional filing capability.

15 Referring now to **FIG. 2**, a single originating filer application is illustrated executing on workstation 221. In an illustrative configuration, the originating filer application communicates with an intellectual property filing portal **210** implemented as an information service executing on a networked information server via a communication network, e.g., World Wide Web, preferably a public, packet-switched data network with Virtual Private Networking (VPN) 20 support. In the illustration of **FIG. 2**, two intellectual property filings are processed. Each is transacted via the network and intellectual property filing portal **210**; however the first is filed **209A** with European Patent Office **241** and **209B** with Japanese Patent Office **253** after being transacted with information systems **231** and **234** of respective European and Japanese 25 associates. The second is transacted without an associate intermediary and is filed **209C** directly in the United States Patent and Trademark office acting as receiving office **242** under the Patent Cooperation Treaty.

A foreign filing session is initiated (201) by authenticating and requesting target jurisdiction and associate information from intellectual property filing portal

5 filing documents to the appropriate associates for filing. Preferably, the forwarding is in computer readable form so that, if available in the corresponding target jurisdiction, filings can be made electronically by the corresponding associates. However, for at least some associates and presently for all patent offices, it is expected that filing documents will be transmitted in hard copy form. Intellectual property filing portal **210** maintains as part of its associate registrations a computer readable encoding of suitable transmission means.

10 In a representative configuration, target- and associate-specific requirements, including form documents, formal requirements and fee schedules supplied (**205**) by intellectual property filing portal **210** are previously supplied (**251A**, **251B**, **252**) in computer readable form by respective associates and/or targets. Alternatively, such information may be maintained by the 15 respective associates and retrieved on demand by intellectual property filing portal **210** in response a particular user's foreign filing session. Suitable storage configurations for target- and associate-specific requirements data may vary from associate to associate.

15 Associate data, including name, address, registration numbers, e-mail or other electronic information service address, telephone and facsimile numbers, etc. may be supplied by the intellectual property filing portal to populate a generic set of form documents for each of the selected target jurisdictions. Alternatively, or for at least some associates and/or jurisdiction, form documents particular to a specific associate may be obtained by, or stored in a data store accessible to, the intellectual property filing portal.

20 **FIG. 3** illustrates exemplary originating filer side data and control flows in an intellectual property filing configuration in accordance with an embodiment of the present invention. Specifically, after initiating a session with the filing portal, the originating filer side application performs, for each matter to be foreign filed, a selection of target jurisdiction and of associate. In each case, an encoding of target jurisdictions and associates is supplied by intellectual property 25 filing portal **310**. Once target jurisdictions and associates are selected, the originating filer side application requests corresponding fee quotations. If the fees quoted by intellectual property filing portal **310** are approved, a fee transaction is authorized (e.g., by debit account, wire transfer, etc.) and preparation of formal document is begun. If not, the

Based on data retrieved (402) from a database, e.g., that of document system 423, the annuity payment application identifies payments meeting user definable temporal or other criteria (e.g., client, payment type, due date, etc.) and presents the user with a set of payments for selection (or deselection). In realizations in which parameterized fee data 411 is supplied, the 5 annuity payment application may also calculate and present exact or estimated fees to facilitate user decisions. Based on this presentation, the user of workstation 421 selects (404) a particular set of payments to be made in target jurisdiction(s). Where required, the selection includes a designated agent as an associate. In the illustrated case, the user selects three payments from amongst three or more possible payments matching the user definable criteria. In particular, the 10 user selects a first payment (e.g., for an application pending in the Canadian Patent Office), a second payment (e.g., for an EPC application pending in the European Patent Office) and a third payment (e.g., for a issued U.S. Patent). In response to the user's selection (404), intellectual property annuity portal 410 may selectively supply (405) workstation 421 with target- and associate-specific form document such as powers of attorney, if required. In some realizations, 15 fee and/or cost information initially supplied (e.g., at 403) is now confirmed or more precisely calculated and supplied (405) to workstation 421.

In any case, the user authorizes (406) the making of the selected set of payments. Fees are transacted (412) as between the authorizing user (or his/her organization) and intellectual property annuity portal 410 coincident with the authorization. In some realizations, the 20 transaction is initiated (412A) from workstation 421. In others, transaction is initiated from intellectual property annuity portal 410 in response to authorization 406. In general, fees are transacted using a payment system 422 which may include pre-authorized electronic funds transfers between financial institutions, credit card authorizations, etc. In some realizations, fees are transacted at least in part by debiting a user's deposit account or accounts with the 25 intellectual property annuity portal organization and/or with a particular target jurisdiction or associate. In some realizations, payment systems may include target jurisdictions and/or associates and payments to particular systems may include target jurisdictions and/or associates and payments to particular target jurisdictions and associates may also be made (412B) coincident with authorization 406. However, in other realizations, authorized payments may be 30 made independently or through alternate payment system facilities.

Typically, form documents, if any, are supplied in a computer readable encoding such that application software on workstation **421** may populate the documents with matter specific data (e.g., docket data, originating agent data, etc.) retrieved from a data store. As before, particular implementations may employ local and/or remote stores, network information services, file servers, and/or applications with callable interfaces such as database management systems, docket systems (e.g., docket system **423**), document management systems, etc.

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In some realizations, software executing on workstation **421** transmits (**407**) target jurisdiction- and/or associate-specific documents (e.g., executed powers of attorney) to intellectual property annuity portal **410** coincident with authorization **406**. Preferably, such documents are transmitted to intellectual property annuity portal **410** in electronic form.

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However, in some configurations, some of the documents are printed (e.g., using printer **424**), signed and transferred in hardcopy form to the intellectual property annuity payment facility or corresponding associate. In situations where original signatures are required, an overnight courier may be employed. Alternatively, if consistent with the requirements of a particular target jurisdiction, signed formal papers may be faxed (**407A**) from fax machine **426**, or scanned (**425**) and transmitted (**407**) electronically, to intellectual property annuity portal **410** or to the corresponding associate. Preferably, signed form papers are scanned and transmitted in a manner that unambiguously associates them with authorization **406**. For example, in one suitable realization, transmission **407** and authorization **406** are implemented as a single

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combined information transaction. In one such implementation, a scanned image (or images) of signed formal papers is (are) supplied as an attachment to authorization message encoded as email.

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Intellectual property annuity portal **410** receives (**407**) the user's authorization from workstation **421** and, in turn through not necessarily immediately, initiates payments (e.g., **408B** and **408C**) in the target jurisdictions corresponding to selected payments. In situations where an authorized in-country agent is required, payment (e.g., **409**) may be initiated (e.g., **408A**) via the selected associate (e.g., **431**). Preferably, each of the payments is initiated in electronic form although any payment system is generally suitable for transactions as between intellectual property annuity portal **410** and the target jurisdiction or associate. However, for at least some associates and presently

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**APPENDIX C**  
**Marked-up copy of Amended Claims**

**WHAT IS CLAIMED IS:**

1       1.     (Amended) A computer implemented method for transacting an  
2     intellectual property service in connection with the filing of documents and/or payment  
3     of fees relative to one or more target jurisdictions, the method comprising:

4       providing presenting a user with information representative of one or more  
5       intellectual property services and one or more associated fees associated  
6       therewith wherein the fees include one or more of:

7               official fees, and

8               service fees; and

9       in response to selection by a the user of one or more of the intellectual property  
10      services, initiating performance of the selected one or more intellectual  
11      property services, and substantially coincident with performance thereof,  
12      therewith, transacting the associated one or more fees.

1       2.     (Amended) The method of claim 1,

2       wherein the intellectual property services include one or more of paying an  
3       annuity or maintenance fee, making an intellectual property filing on  
4       behalf of the user, and preparing and/or filing target jurisdiction- and  
5       associate- specific form documents for directing and/or effecting the  
6       filing and/or payment thereof.

1       3.     (Amended) The method of claim 1,

2 wherein the fee transacting includes one or more of authorizing a debit of a  
3 deposit account, supplying an invoice, and processing the fee transaction  
4 via a payment system.

1 4. (Amended) The method of claim 1, further comprising:

2 presenting a user with one or more~~a set of~~ target jurisdictions and one or more  
3 ~~associates~~associates for each of at least a portion of said  
4 target jurisdictions~~, therefore,~~

5 wherein the fees associated with a particular one or ones of the intellectual  
6 property services are further particularized by target jurisdiction and/or said one  
7 or more~~and~~ respective associates.

1 5. (Amended) The method of claim 1, further comprising:

2 automatically initiating the providing~~presenting~~ of information representative of  
3 one or more intellectual property services in response to a docket event  
4 for a particular intellectual property matter corresponding thereto.

1 6. (Amended) The method of claim 1, further comprising:

2 retrieving information characterizing an intellectual property application  
3 corresponding to one or more intellectual property services information  
4 from a data store; and  
5 calculating the associated one or more fees based on at least a portion of the  
6 intellectual property application information.

1           7.    (Amended) The method of claim 1, further comprising  
2           supplying information encoding the selected one or more intellectual property  
3           services and the associated transacted one or more fees for use in an  
4           accounting system.

1           8.    (Amended) A computer implemented method for transacting intellectual  
2           property annuity, maintenance or renewal fee payments, the method comprising:

3           providing, responsive to presenting, based on docket data, information  
4           representative a user with a set of of one or more intellectual property  
5           matters and one or more fee payments associated therewith, wherein the  
6           fees include one or more of: associated

7           annuity,

8           maintenance or

9           renewal fee payment; and

10          in response to selection by a the user of one or more of the intellectual property  
11          matters and associated one or more fee payments, initiating performance  
12          of the selected one or more fee payments, and substantially coincident  
13          with initiating thereof therewith, initiating a n associated payment  
14          transaction corresponding to the selected one or more fee payments  
15          between the user and an intellectual property annuity, maintenance or  
16          renewal fee payment service.

1 9. (Amended) The method of claim 8,

2 wherein the providing of information representative presenting with a set of one  
3 or more intellectual property matters and associated one or more fee  
4 payments, and the initiating performance of the selected fee payments  
5 are performed by the intellectual property annuity, maintenance or  
6 renewal fee payment service.

1 10. (Amended) The method of claim 8,

2 wherein at least the providing of information representative of one or more  
3 presenting with a set of intellectual property matters and associated one  
4 or more fee payments is performed by an intermediary separate from the  
5 intellectual property annuity, maintenance or renewal fee payment  
6 service.

1 11. (Amended) A method of operating an information service to facilitate fee  
2 transactions in connection with the filing of documents and/or payment of fees relating  
3 to intellectual property services in one or more target jurisdictions, the method  
4 comprising:

5 registering for each of plural associates, at least one target jurisdiction and a  
6 computer readable encoding of fees for one or more intellectual property  
7 services performed by the associate therein; and

8       distributing information representative of one or more of the at least a subset of  
9       the registered target jurisdiction, - and at least a portion of one ore more  
10      associates registered therefore and corresponding associate specific fees,  
11      to a an intellectual property service user for use in transacting at least  
12      one of the associated intellectual property services using a respective one  
13      or ones of the associates.

1       12.    (Amended) The method of claim 11,

2       wherein the distributing distribution is responsive to selection by the intellectual  
3       property service user of one or more of the target jurisdictions and, for  
4       each selected target jurisdiction, a respective one or ones of the  
5       associates.

1       13.    (Amended) The method of claim 11,

2       wherein the distributing distribution includes supplying, on a periodic basis,  
3       periodic supply to the intellectual property service user, of the computer  
4       readable encoding of fees ~~for services~~.

1       14.    (Amended) The method of claim 11,

2       wherein the distributing distribution is encoded by a transmittal in at least one  
3       computer readable medium selected from the set of a disk, CD-ROM,  
4       tape or other magnetic, optical, or electronic storage medium and a  
5       network, wireline, wireless or other communications medium.

1        15. (Amended) An information system for transacting fees associated with  
2        intellectual property services in connection with the filing of documents and/or payment  
3        of fees relative to one or more target jurisdictions, the information system comprising:  
4        via

5        a network including an originating node and plural target nodes, the target nodes  
6        corresponding to associates licensed or otherwise authorized to perform intellectual  
7        property services in one or more target jurisdictions, comprising:; and

8        an intellectual property service portal coupled by the network to the originating  
9        node and one or more of the target nodes, the intellectual property  
10      service portal responsive to a selection at the originating node of at least  
11      one intellectual property service, supplying the originating node with  
12      information representative of one or more particularized fees for  
13      corresponding to the selected at least one intellectual property service,

14      the intellectual property service portal further responsive to initiation, from the  
15      originating node, of the selected at least one intellectual property service,  
16      transacting the one or more particularized fees substantially coincident  
17      with the initiation thereoftherewith.

1        16. (Amended) The information system of claim 15, wherein for a particular  
2        selected target jurisdiction and associate combination, the particularized one or more  
3        fees include:

4           target jurisdiction specific one or more official fees for an intellectual property  
5           filing therein in the particular selected target jurisdiction; and  
6           one or more service fees of the selected associate for performing the selected at  
7           least one intellectual property service.

1       17.    The information system of claim 15,  
2           wherein the originating node includes a computer of a managing attorney or  
3           intellectual property owner; and  
4           wherein the target nodes include computers of respective associates configured  
5           to electronically receive at least partial instructions concerning an  
6           intellectual property filing from the managing attorney or intellectual  
7           property owner via the intellectual property service portal.

1       18.    ~~(Amended)~~ The information system of claim 15,  
2           wherein the originating node includes a web browser;  
3           wherein ~~in~~ the intellectual property service portal includes a web server; and  
4           wherein the selection of at least one intellectual property service, the supplying  
5           of the ~~particularized~~ information representative of one or more fees, and  
6           the transacting of the ~~particularized~~ one or more fees are achieved, at  
7           least in part, using internet protocol traffic between the web browser and  
8           the web server.

1       19.    ~~(Amended)~~ The information system of claim 15,

2 wherein the intellectual property filing portal is further responsive to registration  
3 by the associates of their information representative of one or more  
4 particularized fees corresponding to the associate;

5 wherein the supplied particularized information representative of one or more  
6 fees include those registered by the selected associates.

1 20. The information system of claim 15,

2 wherein the network includes one or more of a packet switched network  
3 segment, a circuit switched network segment, a public network segment,  
4 a private network segment, a public switched telecommunications  
5 network segment, and a virtual private network.

1 21. (Amended) A computer program product encoded in a computer  
2 readable medium for translating an intellectual property service in connection with the  
3 filing of documents and/or payment of fees relative to one or more target jurisdictions,  
4 the computer program product comprising:

5 selection code executable to select from amongst one or more intellectual  
6 property services supported by one or more information services  
7 therefore and to initiate performance of the selected one or more  
8 intellectual property services; and

9 fee transaction code executable to transact one or more fees associated with the  
10 selected one or more intellectual property services substantially  
11 coincident with performance of the one or more intellectual property

12           services thereof by a corresponding one or ones of the information  
13           services.

1           22.    The computer program product of claim 21,  
2           wherein the selection code and the fee transaction code are all executable on a  
3           same processor.

1           23.    The computer program product of claim 21, encoded by or transmitted in  
2           at least one computer readable medium selected from the set of a disk, tape or other  
3           magnetic, optical, or electronic storage medium and a network, wireline, wireless or  
4           other communications medium.

1           24.    An intellectual property filing preparation system in connection with  
2           preparing to file documents and/or to pay fees in one or more target jurisdictions,  
3           comprising:

4           means for selecting from amongst one or more intellectual property services to  
5           be performed in one or more target jurisdictions;

6           means for initiating performance of the selected one or more intellectual  
7           property services; and

8           means for transacting fees substantially coincident with the performance of the  
9           selected one or more intellectual property services.